



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/010,193	01/21/98	GARRISON	D 33500-00004

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TM31/0814

EXAMINER

ROMAIN, J

ART UNIT

PAPER NUMBER

2163

DATE MAILED:

08/14/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action

Application No.
09/010,193

Applicant(s)
Garrison et al.

Examiner
Romain Jeanty

Art Unit
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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Jul 11, 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for the reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search. (See NOTE below);
- (b) ☐ they raise the issue of new matter. (See NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: _____

4. ☐ Applicant's reply has overcome the following rejection(s): _____

5. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claim(s).

6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:
Receiving a set of payment requests for different payees from a "single payor" is not recited in the independent claims. The examiner notes that claim 55 was inadvertently left out in the prior Office action. (See Other below).

7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-7, 11, 13-15, 19-21, 25-31, 35-44, and 47-55

9. ☐ The proposed drawing correction filed on _____ a) ☐ has b) ☐ has not been approved by the Examiner.

10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

11. ☒ Other: Claim 55 was rejected under the same rational of claims 51, 52, 53, and

TADIO R. HAFIZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

Office Action Summary

Application No.
09/010,193

Applicant(s)
Garrison et al.

Examiner
Romain Jeanty

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Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Feb 28, 2001
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 11, 13-15, 19-21, 25-31, 35-44, and 47-55 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 11, 13-15, 19-21, 25-31, 35-44, and 47-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-B92)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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DETAILED ACTION

Response to Amendment

1. This Office action is in response to the amendment filed on March 2, 2001. Applicant has amended canceled claims 22-24, and 45-46, amended claim 49, and added claims 51-55. Claims 1-7, 11, 13-15, 19-21, 25-31, 36-44, 47-55 are pending in the application. The amendment has been considered but ineffective to overcome the 35 U.S.C. 103 rejection of paper No 20.

Claim Rejections - 35 U.S.C. § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-7, 11, 13-15, 19-21, 25-31, and 35-40, are rejected under 35 U.S.C. 103(a) as being unpatentable over **Chang et al.** (Patent No. 5,884,288) in view of **Sharpe et al.** (Patent No. 5,222,018) as set forth in the previous Office action of paper number 20.

4. Claims 7, 25-26 and 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Chang et al.** (Patent No. 5,884,288) in view of **Sharpe et al.** (Patent No. 5,222,018), and further in view of **Pintsov et al.** (Patent No. 5,612,889) as set forth in the prior Office action of paper number 20.

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5. Claims 11 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang et al. (Patent No. 5,884,288), in view of Sharpe et al. (Patent No. 5,222,018), as applied to claim 1 above, and further in view of Mersky et al (Patent No. 6,119,106) as set forth in the prior Office action of paper No. 20.

6. Claims 13-14 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang et al. (Patent No. 5,884,288), in view of Sharpe et al. (Patent No. 5,222,018), as applied to claim 1 above, and further in view of Anderson et al. (Patent No. 6,021,202) as set forth in the prior Office action of paper No. 20.

7. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chang et al. (Patent No. 5,884,288), in view of Sharpe et al. (Patent No. 5,222,018), in view of Anderson et al. (Patent No. 6,021,202) and further in view of Hilt et al. (Patent No. 5,465,206) as set forth in the prior Office action of paper No. 20.

Response to Arguments

8. As per claims 1, 19, 35, 49, and 50, applicant argues that Chang fails to teach or suggest the receipt of respective sets of payment requests, with each set corresponding to an associated set of payors requesting payments to a plurality of payees. The examiner disagrees because Chang does teach a plurality of payors requesting payment request to be made to a plurality of payees. Note the abstract of Chang.

As per claims 2, 3, 21, and 42-43, applicant argues that Chang does not receive differently formatted sets of payment request, and does not suggest a normalization of differently formatted sets of payment request. The examiner disagrees because, it is noted that Chang teaches ensuring proper payment format (col. 9, line 1-12). Therefore, it is the examiner's position that receiving the payments in "first, second, and the third format" operates in the same manner as receiving payments in the proper payment format. The step of normalizing the first payment request to correspond to a normalized format and generating the payment direction based upon the

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normalized first payment requests formal payment would have been obvious to a skilled artisan in order to create a more efficient and effective method of processing the payment requests into a single standard format.

As per claim 7, 25-27, 36-38 and 47, applicant agrees that Pintsov teaches an eleven-digit zip code but not an eleven-digit code to access or retrieve a payee record. The examiner disagrees because combine this type of eleven digit zip code into the Chang's electronic bill payment system would have been obvious to a person of ordinary skill in the art in order to facilitate the delivery of payment data to a user's specific address or location.

Applicant asserted that it appears that claims 8-10 were inadvertently not mentioned.

~~According to paper number 10, it appears that these claims had already been canceled.~~

As per claims 11, 28-30 and 40, Applicant argues that the combination of Chang and Mersky fails to teach or suggest identifying of characters of an account number to select a single delivery point to which payment is directed. The examiner notes that Mersky clearly discloses scanning the customer's information (account number) and sending said information for processing (col. 9, line 8-67). Therefore, It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to incorporate the scanning of the customer's information (account number) in the Chang's system for obtaining customer's payment information as evidenced by Mersky. Doing so would allow Chang with the capability to deliver prompt and efficient payment to his customers.

As per claims 13-15, 31, 39 and 49, Applicant argues that the combination of Chang and Anderson fails to teach or suggest a received account number be altered based on alteration rules. The examiner disagrees with the applicant's argument.. Applicant is directed to paragraph number of paragraph 7 of paper number 20.

As per the added claims 51, 52, 53, 54, Chang fails to explicitly disclose the payor's payment requests are consolidated. Official Notice is taken consolidating payment requests is old and well known in the electronic bill presentment art. It would have been obvious to a person of

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ordinary skill in the art at the time of the applicant's invention to consolidate the payment requests in order to allow multiple payments to be represented by a single payment so that a single electronic payment may represent a large sum.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Romain Jeanty whose telephone number is (703) 308-9585. The examiner can normally be reached on weekdays from 7:30 a.m. to 6:00 p.m.

If attempts to reach the examiner are not successful, the examiner's supervisor, Tariq R. Hafiz, can be reached at (703) 305-9643.

The fax number for Formal or Official faxes to Technology Center 2700 is (703) 308-9051 or 9052. Draft or Informal faxes for this Art Unit can be submitted to (703) 308-5357.

Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703)308-3900.

Romain Jeanty

May 2, 2001.


TARIQ R. HAFIZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER